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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,496	12/22/2000	Albert S. Thompson III	P-3001.2/THO	4087

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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/748,496

Applicant(s)

Thompson III

Examiner

John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 22, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

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## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS (Mixed Class Claim) — 35 U.S.C. §101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful  
process, machine, manufacture, or composition of matter,  
or any new and useful improvement thereof, may obtain a  
patent therefor, subject to the conditions and requirements  
of this title.

2. Claims 10-17 are rejected pursuant to 35 U.S.C. §101 as being “directed to neither a ‘process’ nor a ‘machine,’ but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of

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invention in the alternative only.” (See MPEP 2173.05(p)(II) PRODUCT AND PROCESS IN THE SAME CLAIM).

As per independent claim 10, the preamble recites in part: “A method for reducing emissions from automotive vehicles; the method including the steps of. . . .”; however, the first four paragraphs of the claim recite structural elements, while only the last two paragraphs recite method elements:

**Structural Element Paragraphs**

(1) “providing an automotive vehicle having a fuel tank and a fuel tank fill tube in fluid communication with the fuel tank. . . .”

(2) “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .”

(3) “providing a message-bearing element bearing a message worded to remind an automotive vehicle operator to accomplish a task related to vehicle emission reduction. . . .”; and

(4) “providing the message-bearing element on the replacement gas cap. . . .”

**Method Element Paragraphs**

(5) “removing any existing gas cap from the fuel tank fill tube. . . .” ; and

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(6) “installing the replacement gas cap in a sealing relationship on the fuel tank fill tube.”

For example, in this case, the Examiner interprets the gerund “providing” as a verbal noun that expresses the state of being and the condition of “having”; therefore, in this case, the Examiner interprets the phrase “providing an automotive vehicle having a fuel tank. . . .” as “[having] an automotive vehicle. . . .”

Dependent claims 11-17 are rejected pursuant to 35 U.S.C. §101 for substantially the same reasons as claim 10 because said claims depend from claim 10 and/or intervening base claims.

Appropriate corrections are required.

#### **CLAIM REJECTIONS — 35 U.S.C. §112 ¶1**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the

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same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-17 are rejected under 35 U.S.C. 112, first paragraph for the following reasons:

As per claim 10, even though the specification may be enabling for closing and sealing a fuel tank fill tube, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate with the broad recitation of the intended use of the claim language "configured to close. . . ." (See claim 10, ll. 6-7). The term "configured" renders Claim 10 too broad in scope!

Dependent claims 11-17 are rejected pursuant to 35 U.S.C. §112 ¶1 for substantially the same reasons as claim 10 because said claims depend from claim 10 and/or intervening base claims.

Furthermore, claim 12, ll. 6 & 8 recite the term "configured" and therefore said claim suffers from undue breadth.

Appropriate corrections are required.

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**CLAIM REJECTIONS (Mixed Class Claim) — 35 U.S.C. §112 ¶2**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Indefiniteness due to Ambiguity of Mixed Class Claim**

4. Claims 10-17 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

As per claim 10, said claim as drafted is ambiguous because it is directed to neither a process nor a machine, but rather embraces or overlaps two different statutory classes of invention. Id.

Dependent claims 11-17 are rejected pursuant to 35 U.S.C. §112 ¶2 for substantially the same reasons as claim 1 because said claims depend from claim 1 and/or intervening base claims.

Appropriate corrections are required.

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**CLAIM REJECTION — 35 U.S.C. §112 ¶2**

**Improper Markush Group**

5. Claim 11 is rejected as indefinite pursuant to 35 U.S.C. §112 ¶2 as reciting an improper Markush Group.

Claim 11, ll. 5-9 recites in part:

“selected from the group . . . including: replacing the gas cap, accomplishing vehicle maintenance, purchasing a product, purchasing a service, and testing vehicle emission levels.”

Claim 11 is drafted in improper Markush form and therefore indefinite because the terminology “selected from the group . . . including A, B; and C” is used in place of “selected from the group . . . consisting of A, B and C” or “wherein the group . . . is A, B or C.” (See MPEP 2173.05(h)).

Also, claim 11, line 5 suffers from a minor typographical error: after the word “from” delete the word --of-- (first occurrence).

Appropriate correction is required.



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**CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Galbo 5,062,541 (11/05/1991) (herein referred to as “Galbo”) in view of Harris 6,230,549 (05/15/2001 [US f/d: 4/25/2000] (herein referred to as “Harris”).

As per claim 10, Galbo (FIG. 1; FIG. 2; FIG. 4) shows: “providing an automotive vehicle having a fuel tank and a fuel tank fill tube in fluid communication with the fuel tank. . . .”

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Galbo (FIG. 4; and col. 2, ll. 1-7) discloses a gas filler cap with a message on the cap designed to remind the consumer “*a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .*” (see Galbo (col. 2, ll. 1-7)). The Examiner interprets the disclosure of Galbo (FIG. 1; FIG. 2; FIG. 4) as “providing the message-bearing element on the replacement gas cap. . . .”

Galbo lacks an explicit recitation of “providing a message-bearing element bearing a message worded to remind an automotive vehicle operator to accomplish a task related to vehicle emission reduction. . . .” even though Galbo reasonably suggests same.

Galbo (FIG. 1; FIG. 2; FIG. 4) reasonably suggests: “A method for reducing emissions from automotive vehicles. . . .” and “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .” (NOTE: It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)).

Galbo lacks an explicit recitation of “A method for reducing emissions from automotive vehicles. . . .” and “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .” even though Galbo suggests same.

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Galbo lacks an explicit recitation of “removing any existing gas cap from the fuel tank fill tube; and installing the replacement gas cap in a sealing relationship on the fuel tank fill tube.”

Harris (FIG. 14) discloses filler caps with emission test messages on the filler caps: “*FAIL*” and “*PASS*.”

Harris (FIG. 14; col. 1, ll. 16-20; col. 1, ll. 34-67; the ABSTRACT; and whole document) discloses: “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .” and “removing any existing gas cap from the fuel tank fill tube; and installing the replacement gas cap in a sealing relationship on the fuel tank fill tube.”

Harris (col. 1, ll. 34-67; the ABSTRACT; FIG. 14; and whole document) reasonably suggests “A method for reducing emissions from automotive vehicles. . . .” and “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .”

Harris proposes gas cap replacement and emission protection and message modifications that would have applied to the system of Galbo. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Harris with the teachings of Galbo because such combination would have provided “*a mechanism with the cap to deliver a reminder message to a person removing*

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*the cap from the filler tube. . . .*” (see Galbo (col. 2, ll. 1-7)) and because such combination would have provided means *“to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .*” (see Harris (col. 1, ll. 16-20)).

As per claim 11, Galbo in view of Harris shows the method of claim 10. (See the rejection of claim 10 supra).

Galbo (FIG. 4; and col. 2, ll. 1-7) discloses “providing a message-bearing element includes the step of providing a message recommending accomplishment of . . . purchasing a product. . . .” (i.e., purchasing diesel fuel).

Galbo lacks an explicit recitation of “providing a message-bearing element includes the step of providing a message recommending accomplishment of one or more tasks selected from of[sic] a group of tasks including: replacing the gas cap, accomplishing vehicle maintenance, purchasing a product, purchasing a service, inspecting the vehicle for safety problems, and testing vehicle emission levels.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Galbo (FIG. 4; and col. 2, ll. 1-7) in view of the disclosure of Harris (FIG. 14; col. 1, ll. 16-20; col. 1, ll. 34-67; the ABSTRACT; and whole document) would have been selected in accordance with “providing a message-bearing element includes the step of providing a message recommending accomplishment of one or more tasks selected from of[sic] a group of tasks including: replacing the gas cap,

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accomplishing vehicle maintenance, purchasing a product, purchasing a service, inspecting the vehicle for safety problems, and testing vehicle emission levels. . . .” because such selection would have provided *“a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .”* (see Galbo (col. 2, ll. 1-7)) and because such selection would have provided means *“to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .”* (see Harris (col. 1, ll. 16-20)).

As per claims 13-17, Galbo in view of Harris shows the method of claim 10 and the methods of subsequent base claims depending from claim 10.

Galbo lacks an explicit recitation of the elements and limitations of claims 13-17 even though Galbo in view of Harris reasonably suggests all of the elements and limitations of claims 13-17.

“Official Notice” is taken that both the concepts and the advantages of the elements and limitations of claims 13-17 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include all of the elements and limitations of claims 13-17 because such inclusion would have provided *“a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .”* (see Galbo (col. 2, ll. 1-7)) and because such inclusion would have provided means *“to seal properly the fuel tank filler necks of vehicles so that, for*

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*environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .*" (see Harris (col. 1, ll. 16-20)).

### RELEVANT PRIOR ART

7. The prior art reference made of record and not relied upon are considered pertinent to Applicant's disclosure:

#### U.S. Patents

4,688,343, U.S. Pat. [May 12, 1998] Allan 40/592

"MESSAGE DOME FOR AUTOMOTIVE VEHICLES." This reference discusses using automobiles for advertising. (See the ABSTRACT). Ref. claims 10-17.

### Information Disclosure Statement References Not Considered

8. 37 CFR 1.98(a)(2) requires a legible copy of each U.S. and foreign patent, each publication or that portion which caused it to be listed. The references listed on the IDS which are crossed through are not found in the application. Therefore, the references crossed through have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

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### CONCLUSION

9. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Patent Examiner

May 31, 2003

